R-E-M-A-R-K-S

Claims 1-9, 11-19 and 21-22 remain unchanged from the last amendment.

Claims 1-9, 11-19 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bhatia (US Patent N°6,023,724) in view of Allard. (US Patent N°5,739,689).

The Applicant fully disagrees.

As stated in MPEP section 2142, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

With respect to the suggestion or motivation, the Applicant submits that there is **no suggestion or motivation to combine Bhatia (US Patent 6,023,724) in view of Allard. (US Patent 5,739,689)**.

The Applicant believes that Allard deals with a completely different problem than the one addressed by the present invention. Allard deals with node naming issues in the context where different naming protocols are used in the **same** network of sub-networks (LANs). It does not deal with problems of a LAN connecting with a **remote** network as in the present invention. It does not deal with the incorporation of DNS functionality into a network modem device either.

Allard discloses that there is a set of criteria that must be met to return an address to the LAN node. In some cases, when the domain name is in Cache 54, it will **not** return the address to the LAN node (see Figure 3, when the response type is negative, the network address is unknown). So even though the node name is local, it is possible that it will not return an address. This

situation does not occur in the claimed invention. Cache 54 is simply not for the same purpose as it is in the present invention.

Furthermore, when proxy 14 determines that a node name (which is not the same as a DNS) cannot be found in Cache 54, it transmits a p-node query (which is not a DNS request) to the Name Server 32 (which is not an external DNS on a remote network). The Name Server 32 then responds and the information is stored in Cache 54. **No response is sent** to the node requesting the address. This is explicit in Allard's Column 8, lines 9-14. This is therefore contrary to the limitation of claim 1 which states "*said DNS relay module generates a DNS request and transmits said DNS request to an external DNS on said remote network via said local connection to said router, and said DNS relay module* ***returning a reply from said external DNS to said LAN*** *via said local connection to said router to respond to said request for a numeric address when said domain name requested is not on said list.*"

With respect to the reasonable expectation of success, the Applicant submits that there is no such evidence in the references. This is clear from the fact that the two references are not analogous and that such expectation of success cannot be found. The Examiner is requested to submit his arguments regarding expectation of success.

At this point, the Applicant urges the Examiner to carefully analyze both references to avoid unnecessary resource and time consuming prosecution. The Applicant submits that there is **a contradiction** in the arguments of the Office Action. More precisely, at Page 3 of the Examination Report, the Examiner stated "*Bathia does not explicitly indicate a list of domain names looked up on an external DNS corresponding attribute data and that the DNS relay module uses said list and attribute data without connecting to said external DNS when resolving said DNS name*". In the same Office Action, the Examiner states at Page 9 "Allard, is being relied upon to improve the DNS cache storage in the reference Bathia. In Bathia, the device checks the local static cache to see if it can handle the DNS request, **if not it accesses a remote server** to resolve the

request and return that result to the local node (Column 6, Line 1-29)." (emphasis added). Such statement is in contradiction with the preceding statement. Moreover the reference cited to support this statement i.e. Column 6, Line 1-29 does not disclose such information. It discloses "*Use of the internal DNS server provides local name to address resolution such that, for the user convenience and simplicity, each workstation on the LAN can be addressed in terms of its machine name rather than its IP address. Furthermore, the DNS server, by using the same shared database as does the DHCP server, operates transparently of any user to acquire machine names of **all the workstations connected to the LAN** and then provide suitable machine name to IP address resolution, as needed for all communication between the LAN modem and these workstations themselves.*" (emphasis added). The Examiner is hereby requested to explain how a workstation on the LAN can be interpreted to mean a remote server.

With respect to the combined references and their teaching of all the limitations, the Applicant again believes that this requirement is not met.

As explained in the previous response, the Applicant believes that Bhatia teaches away from the claimed invention. It does not and cannot return a domain name from a list of domain names looked-up on an **external** DNS.

The Applicant therefore believes that there are no grounds for maintaining a rejection of the claims on file under 35 U.S.C. 103(a) and hereby respectfully requests the Examiner to withdraw the rejection.

The Applicant submits that the corresponding patent application in Europe has matured in a European Patent. The Applicant urges the Examiner to reconsider his rejection.

In view of the arguments submitted above, the Applicant believes that independent claims 1 and 13 are not obvious and are patentable over the cited prior art. The Applicant further believes that the dependent claims are patentable as they are dependent on claims which are otherwise patentable.

In view of the foregoing, it is believed that claims 1-9, 11-19 and 21-22 are allowable over the prior art and a Notice of Allowance to this effect is earnestly solicited.

Respectfully submitted,
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